

Remarks/Arguments

Cited Material Used As Reference In Application Defense

1. MPEP - 35 U.S.C. 102 - Application of

2131 Anticipation - Application of - 2100 Patentability

2131 Anticipation - Application of 35 U.S.C. 102(a), (b), and (e) [R-1]

35 U.S.C. 102 Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

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(e) the invention was described in - (1) an application for patent, published under **section 122(b)**, by another filed in the United States before the invention by the applicant

for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in **section 351(a)** shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under **Article 21(2)** of such treaty in the English language; or<

(f) he did not himself invent the subject matter sought to be patented, or

(g)(1) during the course of an interference conducted under **section 135** or **section 291**, another inventor involved therein establishes, to the extent permitted in **section 104**, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

>"When a claim covers several structures or compositions, either generically or as

alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See **MPEP § 2131.01**.

2. MPEP - 2141 35 U.S.C. 103

2141 35 U.S.C. 103; the Graham Factual Inquiries [R-3]

35 U.S.C. 103 Conditions for patentability; non-obvious subject matter.

(a)

A patent may not be obtained though the invention is not identically disclosed or described as set forth in **section 102** of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b)

(1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under **section 102** and nonobvious under subsection (a) of this section shall be considered nonobvious if-

(A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and

(B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.

(2) A patent issued on a process under paragraph (1)-

(A) shall also contain the claims to the composition of matter used in or made by that process, or

(B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding **section 154**.

(3) For purposes of paragraph (1), the term "biotechnological process" means-

(A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to-

(i) express an exogenous nucleotide sequence,

(ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or

(iii) express a specific physiological characteristic not naturally associated with said organism;

(B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and

(C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).

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(c)

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of **section 102** of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if -

(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(3) For purposes of paragraph (2), the term "joint research agreement" means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.<

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I. < STANDARD OF PATENTABILITY TO BE APPLIED IN OBVIOUSNESS REJECTIONS

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.

The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as

negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy is to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under **35 U.S.C. 103**. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

The Supreme Court reaffirmed and relied upon the *Graham* three pronged test in its consideration and determination of obviousness in the fact situations presented in *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 189 USPQ 449, *reh'g denied*, 426 U.S. 955 (1976) and *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 163 USPQ 673 (1969). In each case, the Court discussed whether the claimed combinations produced a "new or different function" and a "synergistic result," but it clearly decided whether the claimed inventions were nonobviousness on the basis of the three-way test in *Graham*. Nowhere in its decisions in these cases does the Court state that the "new or different function" and "synergistic result" tests supersede a finding of nonobvious or obviousness under the *Graham* test.

Accordingly, examiners should apply the test for patentability under **35 U.S.C. 103** set forth in *Graham*. See below for a detailed discussion of each of the *Graham* factual inquiries. It should be noted that the Supreme Court's application of the *Graham* test to the fact

circumstances in *Ag Pro* was somewhat stringent, as it was in *Black Rock*. Note *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F.2d 963, 200 USPQ 769 (7th Cir. 1979). The Court of Appeals for the Federal Circuit stated in *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1540, 218 USPQ 871, 880 (Fed. Cir. 1983) that

A requirement for "synergism" or a "synergistic effect" is nowhere found in the statute, 35 U.S.C. When present, for example in a chemical case, synergism may point toward nonobviousness, but its absence has no place in evaluating the evidence on obviousness. The more objective findings suggested in *Graham*, supra, are drawn from the language of the statute and are fully adequate guides for evaluating the evidence relating to compliance with 35 U.S.C. § 103. *Bowser Inc. v. United States*, 388 F. 2d 346, 156 USPQ 406 (Ct. Cl. 1967).

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II. < BASIC CONSIDERATIONS WHICH APPLY TO OBVIOUSNESS REJECTIONS

When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is the standard with which obviousness is determined.

Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

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III. < OBJECTIVE EVIDENCE MUST BE CONSIDERED

Objective evidence or secondary considerations such as unexpected results, commercial success, long-felt need, failure of others, copying by others, licensing, and skepticism of experts are relevant to the issue of obviousness and must be considered in every case in which they are present. When evidence of any of these secondary considerations is submitted, the examiner must evaluate the evidence. The weight to be accorded to the evidence depends on the individual factual circumstances of each case. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987). The ultimate determination on patentability is made on the entire record. *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

>However, evidence developed after the patent grant in response to challenge to the patent validity's should not be excluded from consideration since "understanding the full range of the invention is not always achieved at the time of filing the patent application." *Knoll Pharms. Co., Inc. v. Teva Pharms. USA Inc.*, 367 F.3d 1381, 1385, 70 USPQ2d 1957, 1960 (Fed. Cir. 2004). (reversing the lower court's grant of summary judgment of invalidity for failure to consider 'unexpected results' evidence obtained from post-filing that could be relevant to the patent validity inquiry).<

See **MPEP § 716 - § 716.06** for a discussion of objective evidence and its role in the final legal determination of whether a claimed invention would have been obvious under **35 U.S.C. 103**.

Supporting Court Cases

1.

[HN3] Anticipation is a question of fact. In order to anticipate, there must be identity of invention; thus, the claimed invention, as described in appropriately construed claims, must be the same as that of the reference. More specifically, under 35 USCS 102 (b), a patent claim is anticipated by a prior art reference if the reference discloses, either expressly or inherently, each and every element of the claimed patent. Every element of a claimed invention must be identically shown in a single reference for a prior art reference to anticipate. (Danny J. Elder and Enviro-Stain, Inc. Plaintiffs, v A.S.Tanner and Tanner Forest Products, Corp., Defendants; Case No. 1:98-CV-36; United States District Court For the Eastern District Of Texas, Beaumont Division; 180 F. Supp. 2nd 818; 2001 U.S. Dist. LEXIS 23054)

2.

[HN31] The test of obviousness in 35 U.S.C.S. § 103 is the primary condition of patentability. Obviousness hinges on four factual findings: (1) the scope and content of the prior art; (2) the differences between the prior art and the claims; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Metabolite laboratories, Inc. and Competitive Technologies, Inc., Plaintiffs-Appellees, v Laboratory Corporation Of America Holding (doing business as LabCorp), Defendant-Appellant*. United State Court Of Appeals For The Federal Circuit 2004 U.S. App. LEXIS 11248

3.

1. 535 F2d 67 *; 1976 CCPA LEXIS 162, **; 190 U.S.P.Q.

(BNA)15

IN THE MATTER OF THE APPLICATION OF MAMORU HIRAO AND
YOSHINORI SATO

Patent Appeal No. 76-560

UNITED STATES CORT OF CUSTOMS AND PATENT APPEALS

MAY 27, 1976 DECIDED

In “Hirao” it reads on a patent can contain both unique and obvious components, so long as these component are applied in a unique manner they are patentable. There are similar components in both Uchiyama and the Applicant’s invention, but there are also different problems to be solved that

require innovations that are not obvious to one skilled in the “Art”. If the approached taken by the Applicant were obvious, there would be many other patent’s utilizing the same methodology. That is to say obvious elements combined with innovation does not preclude obtaining a patent that contains said obvious components so long as they are applied in an unforeseen manner (see cited article).

Examiner’s Arguments

Claim Rejections - 35 USC ~ 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-22 and 25-28 rejected under 35 U.S.C. 102(b) as being anticipated by
Giles US 6,731,950.

As per claims 11, 19 and 25, Giles teaches a method of attaching wired extension phones expressly designed to work with a wireless telephonic device (abstract and figure 1), comprising.

(a) electronically interfacing a wireless telephonic device with one or more extension phones expressly designed to work with a wireless telephonic phone (see figures 1 and 6);

(b) a wireless telephonic device containing an access port with connection pins that have a one to one relation with the extension phone keypad and display (figures 1 and 6. Also see figure 4 step #420 whereby dialed digits are sent to cell phone),

(c) a wireless telephonic device with internal components enabling said device to originate calls on/from the extension phone AND (d) a wireless telephonic device with internal components enabling said device to forward a received call to extension (C1, L45 to C2, L6)

(e) audio is passed between the extension phone and the wireless telephonic device via pins of a connection port interfacing said extension phone and wireless telephonic device AND (f) text is passed to the extension phone on the wireless telephonic device via pins of a connection port (audio and text, eg. caller ID information, is passed to/from mobile device from/to wired device, if/when equipped with a display for caller ID as many wired/cordless phones are today)

(g) the internal components of the wireless device able to detect and respond to keys pressed on the extension phone AND (h) the extension phone keypad buttons and display matches the pin configuration of the cell phone connection port (figure 4, step #420 shows dialed digits on wired phones are sent to cell phone)

As per claims 12,21 and 26, Giles teaches claim 11/19, wherein a wireless device will-circuitry will be able to use the connection port to forward to the extension phone an audio signal indicating an incoming calls on a wireless telephonic device using the extension phone speaker (C5, L1-27 and figure 5).

As per claim 13, Giles teaches claim 1 1, wherein a wireless device is able to detect when the extension phones goes off hook in response to signaling of a incoming call (C5, L1-27 and figure 5).

As per claims 14 and 20, Giles teaches claim 12/19, wherein a wireless device is able to detect when the extension phones goes off hook for dialing of an outgoing call (04, L20-67 and figure 4).

As per claim 15 and 16, Giles teaches claim 14/11, wherein a wireless device is able to detect when the extension phones goes on hook indicating the termination of calling activity (figure 4, #430 and #435)

As per claims 17-18 and 22, Giles teaches claim 11/17/19, wherein the extension phones will be able to transmit a telephone number dialed on the extension phone to a wireless device as a dial-able phone number (figure 4, #420).

As per claim 27, Giles teaches claim 25, wherein the connection port can be used to link the wireless device to multiple Ezphone extensions (figure 1 shows multiple phones).

As per claim 28, Giles teaches claim 25 wherein the wireless device is able to recharge its batteries while connected to an Ezphone directly or connected to an Ezphone via connection port to a docking station (abstract).

Claim Rejections -35 usc ~ 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-24 rejected under 35 U.S.C. 103(a) as being unpatentable over Cues and further in view of Wonak et al. US 6,778,824 and Robertson GB-2360175.

As per claims 23-24, Giles teaches claim 22/19, but is silent on wherein the extension phones will be linked to the wireless device via a connection port and the connection port will be for a connection that will not require interfacing component for connection. The two to occur AND/OR an wireless device circuitry is configured for enable

all interfacing components required to link to an EZ-phone extension be located inside of a wireless device, and the wireless device is able to detect linkage to an EZphone extension.

Robertson teaches connecting a wired phone to a DECT phone (eg. wireless phone) which provides RF connectivity whereby all electronics are contained in the wireless device/base unit (abstract and figure 1).

Wonak et al teaches coupling a wired phone to a mobile phone via wireless interface (see abstract and figures).

It would have been obvious to one skilled in the art at the time of the invention to modify Giles, such that the extension phones will be linked to the wireless device via a connection port and the connection port will be for a connection that will not require interfacing component for connection to occur, to provide a direct connection between the wired phone and cell phone without need for a base unit.

Applicant Response To Examiner's Arguments

According to MPEP "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001)...". Therefore Giles US-6,731,950 B1 to anticipate the Applicant, there would have to be teaching on a one to one relationship between the buttons of the cellular phone and the extension phone, allowing for combining the two keypads into a common keypad totally negating the need for interfacing components.

As per claims 11, 19 and 25, Giles does not teaches a method of attaching wired extension phones expressly designed to work with a wireless telephonic device (abstract and figure 1), comprising.

(a) electronically interfacing a wireless telephonic device with one or more extension phones expressly designed to work with a wireless telephonic phone (see figures 1 and 6);

Abstract

An interface box links a user's cellular telephone with all the standard telephone extensions at the user's home or office. In this way, the portable cellular telephone is the interface between the user's telephone extensions and the telephone company. The interface box connects to the cellular telephone's access connector, for example, whenever the cellular telephone is laid in a cradle of the interface box. Through this connector is sent all power, signal and input/output connections. In addition to the interface circuitry, the interface box preferably recharges the cellular telephone's battery.

Referring to FIG. 1, fixed extension telephones 110, 115, 120, are connected through standard in-house telephone wiring lines 125, 130, 135 to an interface box or controller base 140. One of the extension telephones 110, 115, 120 may be replaced by a modem of the type used, for example, in a personal computer or facsimile machine. The controller base 140 has a cradle 145 which can receive a portable cellular telephone 150. The controller base cradle 145 has a cellular telephone connector 155 with a

conductor pattern that matches external connectors on the cellular telephone 150. This pattern varies depending upon the manufacturer and model of the cellular telephone 150. The connector 155 can be transformed to conform to different connector patterns of different cell phone manufacturers or models by the use of different modular connector adapters (not shown in the drawings). Referring to FIG. 2, the cellular telephone 150 links the extension telephones 110, 115, 120, through the controller base 140 to the telephone company or telephone network 210 via the nearest cellular transmit/receive site 220. As employed in this specification, the term "telephone company" and the term "telephone network" both refer to the nationwide telephone system consisting primarily of local telephone company telephone wiring and long distance carrier microwave, fiber optic and wire links, as well as to the international calling access this system provides. Communication between the portable cellular telephone 150 and the cellular site 220 is through radio propagation between the antenna 150a of the cellular telephone 150 and the antenna 220a of the cell site 220. Multiple RJ-11 connectors are provided on the controller box 140 to which the various extension telephones 110, 115, 120 may be connected. The extension telephones 110, 115, 120 all respond to incoming calls to the telephone number of the portable cellular telephone 150, and make calls on this same telephone number. FIG. 2 illustrates an alternative embodiment of the controller base 140 in which the controller base 140 has a single line connector and the fan-out from this connector to multiple RJ-11 connectors in the house/office walls is provided externally of the controller base 140, e.g., by in-house telephone wiring.

There is no mention of an expressly designed extension in the Abstract. Figure 1 shows only standard extension phones that attach to the cellular phone via an interfacing box. This is supported by the description of Figure 1 provided by Giles in the specifications.

(b) a wireless telephonic device containing an access port with connection pins that have a one to one relation with the extension phone keypad and display (figures 1 and 6. Also see figure 4 step #420 whereby dialed digits are sent to cell phone);

There is no mention of a wireless telephonic device containing an access port with connection pins that have a one to one relation with the extension phone keypad and display in Figure 4, step 420. However, Giles does teach on using a DTMF decoder to decipher the keys pressed on the keypad. All DTMF-tones decodes chips have a single input pin that is used to detect what tone is being generated by the pressing of a numeric button on a keypad (i.e. CM8880). Giles states that DTMF tones are used to determine what signals are being conveyed from the extension phone to the cell phone microprocessor (Col. 1, line 45 – line 63 & Col. 3, line 42 – line 47).

An interface box links a user's cellular telephone with all the standard telephone extensions at the user's home or office. In this way, the portable cellular telephone is the interface between the user's telephone extensions and the telephone company.

The interface box connects to the cellular telephone's access connector, for example, whenever the cellular telephone is laid in a cradle of the interface box. Through this connector is sent all power, signal and input/output connections. In addition to the interface circuitry, the interface box preferably recharges the cellular telephone's battery.

Whenever the cellular telephone is thus connected to the interface box, each extension telephone at that location will act as though it were hard-wired to a normal

telephone line. The extension telephones will look and act, to the user, just like the telephone system found in most homes or small offices, for example. The multiple extensions will all ring in response to an incoming call on the same telephone line.

The microcontroller 330 senses signals such as DTMF tones from the extension telephones 110, 115, 120 through an analog-to-digital conversion interface 332 connected between the telephone line bus 325 and the microcontroller 330

U.S. Patent

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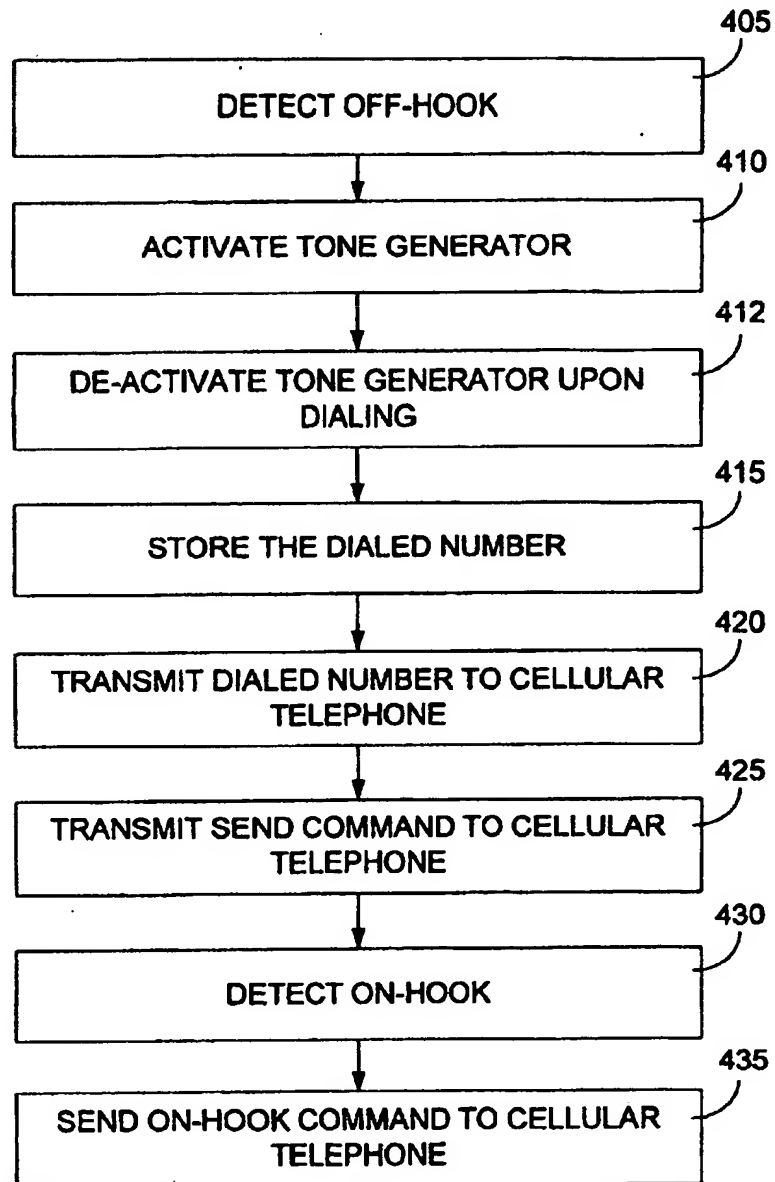


FIG. 4

(c) a wireless telephonic device with internal components enabling said device to originate calls on/from the extension phone AND (d) a wireless telephonic device with internal components enabling said device to forward a received call to extension (C1, L45 to C2, L6)

This section of the specification teaches on the interface box housing the components needed to link the wireless device and the extension phone together. There is no mention of the interfacing components being housed in the wireless device at this citation (C1, L45 to C2, L6). The difference between the Applicant's patent application and Giles patent is the need for components for interfacing. The Applicant's patent application teaches on a one to one correlation between the pins and the buttons on the keypad both the wireless device and the extension phone.

There is no need for interfacing, therefore this citation of Giles patent is of no significance.

An interface box links a user's cellular telephone with all the standard telephone extensions at the user's home or office. In this way, the portable cellular telephone is the interface between the user's telephone extensions and the telephone company. The interface box connects to the cellular telephone's access connector, for example, whenever the cellular telephone is laid in a cradle of the interface box. Through this connector is sent all power, signal and input/output connections. In addition to the interface circuitry, the interface box preferably recharges the cellular telephone's battery.

Whenever the cellular telephone is thus connected to the interface box, each extension telephone at that location will act as though it were hard-wired to a normal telephone line. The extension telephones will look and act, to the user, just like the

telephone system found in most homes or small offices, for example. The multiple extensions will all ring in response to an incoming call on the same telephone line.

With the invention, many locations frequented by the user (i.e., different private offices, different corporate offices, second homes, etc.) may be provided with such an interface box, so that as the user arrives at a given location he puts his cellular telephone into the interface box at that location, and upon departing he removes his cellular telephone from the interface box and takes it with him. Thus, the telephone extension system at each location is activated with the user's cellular telephone number as long as the user is there and is inactivated upon his departure

(e) audio is passed between the extension phone and the wireless telephonic device via pins of a connection port interfacing said extension phone and wireless telephonic device AND (f) text is passed to the extension phone on the wireless telephonic device via pins of a connection port (audio and text, eg. caller ID information, is passed to/from mobile device from/to wired device, if/when equipped with a display for caller ID as many wired/cordless phones are today).

Giles' patent does not teach on this subject matter. The word "Text" does not appear either the specifications or the claims of the patent. The Audio –in/out mentioned in Giles' patent is referred to as part of a bus (Col. 3, line 58 – line 61)

In a preferred embodiment, the cellular telephone connector 155 includes an audio-in connection 370, an audio-out connection 375, a digital-in connection 380 and a

digital-out connection 385. The cellular telephone connector 155 may provide a path for both the audio-out connection 375 and the audio-in connection 370 to the telephone line bus 325,

(g) the internal components of the wireless device able to detect and respond to keys pressed on the extension phone AND (h) the extension phone keypad buttons and display matches the pin configuration of the cell phone connection port (figure 4, step #420 shows dialed digits on wired phones are sent to cell phone)

There is no mention of a wireless telephonic device containing an access port with connection pins that have a one to one relation with the extension phone keypad and display in Figure 4, step 420. However, Giles does teach on using a DTMF decoder to decipher the keys pressed on the keypad. All DTMF-tones decodes chips have a single input pin that is used to detect what tone is being generated by the pressing of a numeric button on a keypad (i.e. CM8880). Giles states that DTMF tones are used to determine what signals are being conveyed from the extension phone to the cell phone microprocessor (Col. 1, line 45 – line 63 & Col. 3, line 42 – line 47). Giles' patent does not teach on matching the buttons of the keypad of the cell phone to the buttons of the extension phone via a one to one relationship with the pins of the connection port. Claims 11 – 22 and 25 – 28 are not anticipated by Giles US 6,731,950, because the claims subject matter of his patent is different from that of the Applicant's patent application.

Claims 11, 19, and 25 are allowable

Claims 12, 13, 14, 15, 16, and 17 are allowable as depends of allowed Claim 11

Claims 20, 21, 22, 23, and 24 are allowable as depends of allowed Claim 19

Claims 26, 27, and 28 are allowable as depends of allowed Claim 25

As per claims 12, 21 and 26, Giles teaches claim 11/19, wherein a wireless device ~~will~~ circuitry will be able to use the connection port to forward to the extension phone an audio signal indicating an incoming calls on a wireless telephonic device using the extension phone speaker (C5, L1-27 and figure 5).

The cited specification is silent on forwarding to the extension phone an audio signal indicating an incoming call on a wireless telephonic device using the extension phone speaker. Figure 4 & 5 are both empty of teachings on this process too, the only teaching provides is of detecting a "Ring Signal" and "Activating A Ring Generator" (Figure 5, Items 505 and 510 respectively). In Giles' patent there is no mention of a speaker being involved in signal an incoming call. The only time a speaker is mention in the patent is with a mute button.

In summary, FIGS. 4 and 5 show that the portable cellular telephone 150 is slaved by the base controller to the extension telephones so that the cellular telephone goes "on-hook" and "off-hook" in response to one of the extension telephones going on-hook and off-hook and dials a number dialed by a user on one of the extension

telephones. Moreover, the base controller renders the extension telephones responsive to the cellular telephone in that they ring upon a call being received by the portable cellular telephone 150.

Claims 12, 21, and 26 are allowable

Claims 12, 21, and 26 are allowable as depends of allowed Claims

As per claim 13, Giles teaches claim 1 1, wherein a wireless device is able to detect when the extension phones goes off hook in response to signaling of a incoming call (C5, L1-27 and figure 5).

The Applicant's invention teaches on extending the circuitry of the cellular phone so that when the extension phone is off hook, it appears as if the cellular phone is in an off hook state. By joining the circuitry of the cellular phone and the extension phone there is not need for extras, the extension phone behaves just like the cellular phone in the Applicant's invention. In Giles' patent the teaching stress the need for interfacing components to make the extension phone work, be the components be located in the base unit or the cellular phone. Giles' patent always requires interfacing components for generating dial tone, generating ringing signals, converting the audio into digital, et cetera. (Col. 5, line 1 – line 12 & Figure 3, Items 310, 315, and 395)

FIG. 5 illustrates the operation of the microcontroller 330 when an incoming telephone call is made via the telephone network to the cellular telephone 150. The

microcontroller 330 detects on the digital in connection 380 a digital ring signal from the cellular telephone 150 (block 505 of FIG. 5). In response, the microcontroller 330 activates the ring generator 315 (block 510). If the user then picks up one of the extension telephones 110, 115, 120, the microcontroller 330 detects an off-hook condition (block 515), and responds by de-activating the ring generator 315 (block 520) and generating a digital "off-hook" command on the digital out connection 385 (block 525) to the cellular telephone 150.

Claims 13 is allowable

Claims 13 is allowable as depend of an allowed Claims

As per claims 14 and 20, Giles teaches claim 12/19, wherein a wireless device is able to detect when the extension phones goes off hook for dialing of an outgoing call (04, L20-67 and figure 4).

The Applicant's approach of combine two separate circuit into a single extended circuit negates the need for sensor to detect the state of the extension phone. What happens to on the extension phone keypad happens on the wireless device keypad. The Applicant's methodology removes the need for the wireless device to detect the state of the extension phone as in Giles' invention (Col. 5, line 1 – line 5 & Figure 4, Items 405 and Item 430).

Claims 14 and 20 are allowable

Claims 14 and 20 are allowable as depend of an allowed Claims

As per claim 15 and 16, Giles teaches claim 14/11, wherein a wireless device is able to detect when the extension phones goes on hook indicating the termination of calling activity (figure 4, #430 and #435).

The Applicant's approach of combine two separate circuit into a single extended circuit negates the need for sensor to detect the state of the extension phone. What happens to on the extension phone keypad happens on the wireless device keypad. The Applicant's methodology removes the need for the wireless device to detect the state of the extension phone as in Giles' invention (Col. 5, line 1 – line 5 & Figure 4, Items 405 and Item 430). The ending of a call on the extension phone will affect the same circuits as if the call was terminate on the wireless device.

Claims 15 and 16 are allowable

Claims 15 and 16 are allowable as depend of an allowed Claims

As per claims 17-18 and 22, Giles teaches claim 11/17/19, wherein the extension phones will be able to transmit a telephone number dialed on the extension phone to a wireless device as a dial-able phone number (figure 4, #420).

The Applicant's approach of combine two separate circuit into a single extended circuit negates the need for sensor to detect the state of the extension phone. What happens to on the extension phone keypad happens on the wireless device keypad. The Applicant's methodology removes the need for the wireless device to detect the state of the extension

phone as in Giles' invention (Col. 5, line 1 – line 5 & Figure 4, Items 405 and Item 430). In Giles' patent the dialed phone number is transmitted as DTMF-tones (Col. 3, line 42 – line 47 & Col. 5, line 46 – line 50), and not as press buttons as in the Applicant's invention.

Claims 14 and 20 are allowable

Claims 14 and 20 are allowable as depend of an allowed Claim

As per claim 27, Giles teaches claim 25, wherein the connection port can be used to link the wireless device to multiple Ezphone extensions (figure 1 shows multiple phones).

Claims 27 is allowable as depend of an allowed Claim

As per claim 28, Giles teaches claim 25 wherein the wireless device is able to recharge its batteries while connected to an Ezphone directly or connected to an Ezphone via connection port to a docking station (abstract).

Claims 28 is allowable as depend of an allowed Claim

As per claims 23-24, Giles teaches claim 22/19, but is silent on wherein the extension phones will be linked to the wireless device via a connection port and the connection port will be for a connection that will not require interfacing component for connection ~~the two~~ to occur AND/OR an wireless device circuitry is configured for enable all interfacing components required to link to an EZ-phone extension be located inside of a wireless device, and the wireless device is able to detect linkage to an EZphone extension.

Robertson teaches connecting a wired phone to a DECT phone (eg. wireless phone) which provides RF connectivity whereby all electronics are contained in the wireless device/base unit (abstract and figure 1).

Wonak teaches coupling a wired phone to a mobile phone via wireless interface (see abstract and figures).

It would have been obvious to one skilled in the art at the time of the invention to modify Giles, such that the extension phones will be linked to the wireless device via a connection port and the connection port will be for a connection that will not require interfacing component for connection to occur, to provide a direct connection between the wired phone and cell phone without need for a base unit.

Robertson (GB-2,360,175) does not teach on placing the interfacing components in the wireless device, in the Abstract. The Abstract teaches on placing the interfacing in the base unit. The Applicant's teaches on removing the need for interfacing components altogether. Wonak et al (U.S. 6,778,824), teaches on coupling a wired phone to a mobile phone via wireless interface (as stated by the examiner in his arguments). Neither Robertson nor Wonak et al teach of completely doing away with interfacing components need to link the extension phone to an wireless device. Giles (U.S. 6,731,950) teaches on placing the interfacing components in either a base controller or in the wireless device itself. In all of the cited prior art there is interfacing components, they differ only in where said components are situated.

(54) Abstract Title

Wireless telephone equipment

(57) The present invention relates to apparatus for connecting wireless telephones to a fixed wired telecommunications network A digital enhanced cordless

telecommunications (DECT) telephone charger unit (100) for a DECT telephone (104) is provided with a standard Private Automatic Branch eXchange IPABX) telephone sacket (110). Any conventional PABX telephone equipment 4112) can connect to the standard PABX telephone socket 411W. The DECT telephone (104) communicates with a DECT base station (102). Also provided in the charger unit (100) is a conversion unit (114). The conversion unit (114) Interfaces between the standard PABX telephone socket 4110) and the DECT telephone (104) in order that conventional telephone exchange facilities, including conference call functions, speaker phone functions and modem connection functions, can be accessed.

The three cited prior arts (Giles, Wonak et al et al, and Robertson) all require interfacing components, therefore none of them can be said to anticipate the Applicant's invention, nor can it be said that the Applicant's invention is made obvious by any of them.

Neither the Abstract of Giles' patent , nor Figure 1 of that patent teaches on a specially designed extension phone. In fact, Giles state that his invention would use a standard extension phone in the Abstract, and the Figure 1 shows only standards phone. In Figure 7, Giles teaches on a modified extension phone, but that embodiment does not eliminate the need for interfacing, it merely relocates the interfacing to the wireless device.

The Applicant's invention in which the wiring of the individual button of the keypad of both the extension phone and the wireless device are joined to form a single circuit the same buttons is new and an improvement over prior art. There is no need for interfacing components, therefore less expense in manufacturing.

Claims 23 – 24 are allowable

Summary of Applicant's Arguments

In Figures 5A and 5B it is shown that the audio circuitry of a cellular phone can be extended to a regular phone with out adding interfacing. This is achieved by tapping into the existing headset circuits of a cellular phone (Paragraphes 0020 & 0030).

[0020] Two wired (line) phones can be used to form an intercom, all that is needed is a power source and a resistor. You can create an intercom out of two wired telephone by connecting the red wires to a 9-volt batter in series with a 300 ohm resistor, and the green wires to one another (FIG. 5).

The Applicant teaches on using the connection port to connect the cellular phone to the extension phone (paragraph 0030). The Applicant distinguishes his invention by teach on standardizing the connections ports of cellular phones or by enabling programming the output of the connection pin).

[0033] The Connection Port (FIGS. 6A & 6B CP) is a group of pins generally located at the bottom of the cell phone (wireless device). This port consists of a number of pins that are used to communication information and/or instructions between an external device and the cell phone. ... Many of the wireless phones already have the ability to convey conversation via the Connection Port to hand-free headsets that contain a microphone and a small speaker.

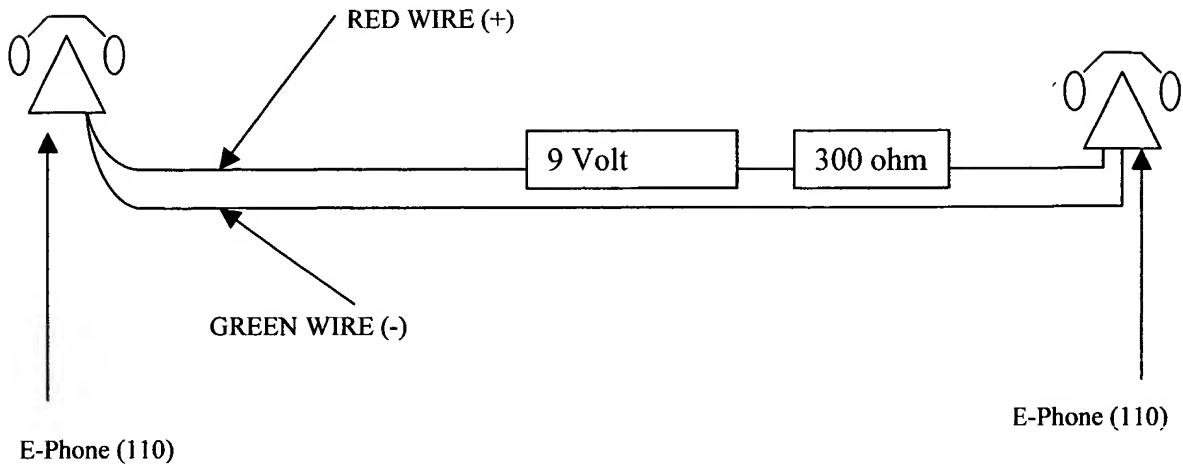


FIGURE 5A

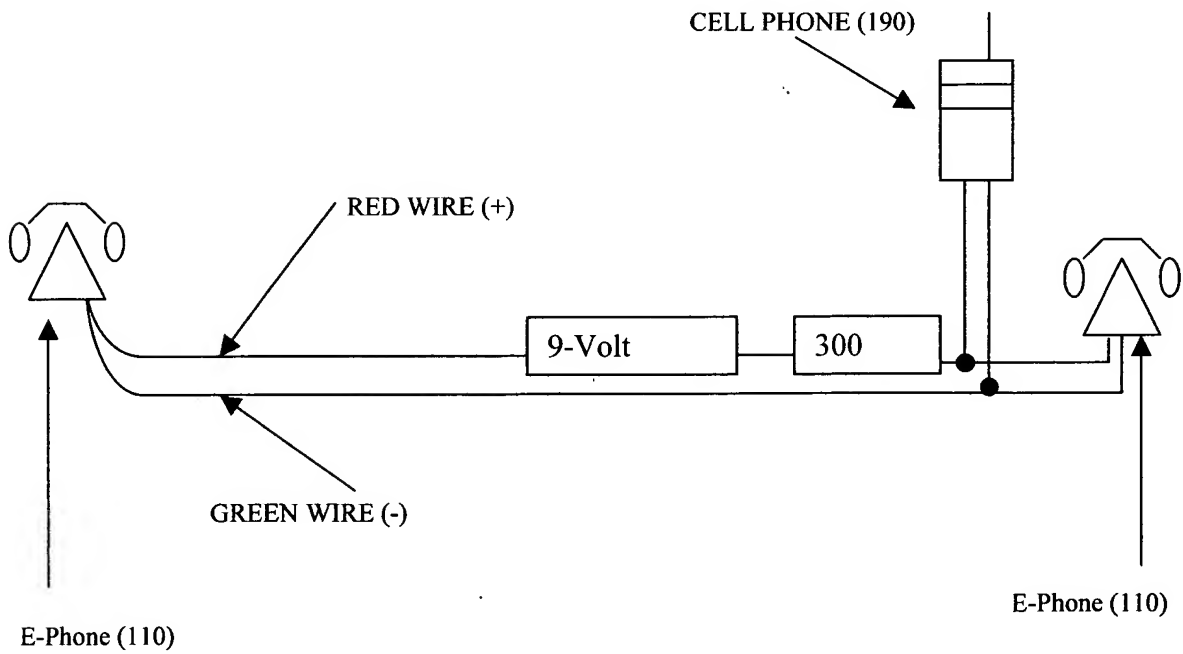


FIGURE 5B

In Figure 11B the Applicant goes on to teach on direct linkage of the circuits of the cellular phone to that of the extension phone via the connection port pins, enabling the extension phone to use the circuitry of the cell phone (paragraphes 0034 & 0046). This process would negate the need for interfacing component in either the cell phone or extension phone (base unit).

[0034] In another embodiment the Pins in the Connection Port may be configured to activate key on the keypad of the cell phone, allowing the Base Unit to transmit instructions/information between the two devices: SkyRider and Cell Phone. The information will take the form of instruction to the cell phone to mimic the pressing certain command keys, or numeric key on the keypad. The SkyRider will be able to transmit commands and a specific Phone Numbers by manipulating the state of various pins/combination of pins composing the Connection Port of the wireless device. The cell phone will be able to communicate back to the Base Unit by manipulating it pins. Since each cell phone company/manufacture may have it own set of proprietary codes for handling input into and out of the cell phone via the connection port, each SkyRider will have to be designed and manufacture for a specific cell phone. However, if at some future date, this is standardized it will be possible for a SkyRider to work with any cell phone (wireless telephony device). Any engineer skilled in the art with access to the proper codes will be able to program the SkyRider to work with a cell phone.

In Figure 11A a cable is used to link the pins of the connection ports together, allowing the formation of a single circuit for each button on the keypads of the two device: cell phone and extension phone. Figure 11B is a detail description of the pin linkage, showing a one to one association between keys and connection port pins. By properly configuring the cellular phone circuitry the pressing of a key on the extension phone keypad will operate the cell phone components that would respond to the pressing of the same button on the cell phone keypad. The extension phone keypad would be an extension of the cell phone's own keypad.

[0046] In alternate embodiment, components normally contained with a cell phone can be used to create a SkyRider. Cell phone have all of the components needed to create a SkyRider already inside of them. All that is needed is external access to these components. By adding an external keypad to the hand-free a speaker and microphone, you will create a SkyRider. FIG. 11 illustrates one embodiment of this approach to creating a SkyRider. The external Keypad and the hands-free headset (microphone and speaker) are linked to the cell phone (wireless device) via the cell phone Connection Port's pins. The Connection Port pins will link external keypad to the same circuits that normally monitor input from the cell phone's normal keypad. When input from either of the two keypads is indistinguishable from one another, and an external speaker and microphone is employed, you will have a SkyRider. Hands-free headsets are already readily to cell phone users, all that is needed is an external keypad and programming of the connection port to accept input from an external source as input from the keypad.

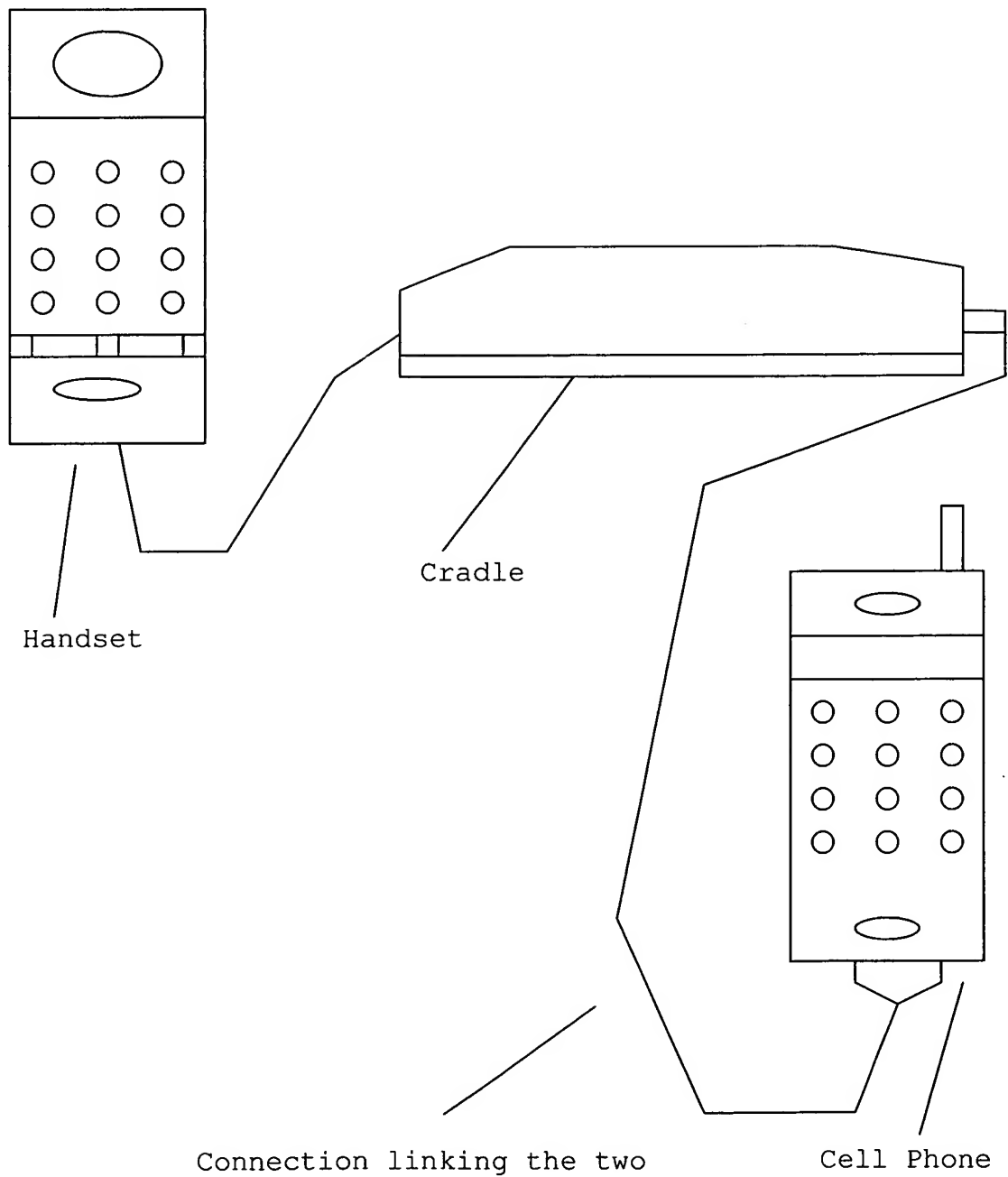


FIGURE 11A

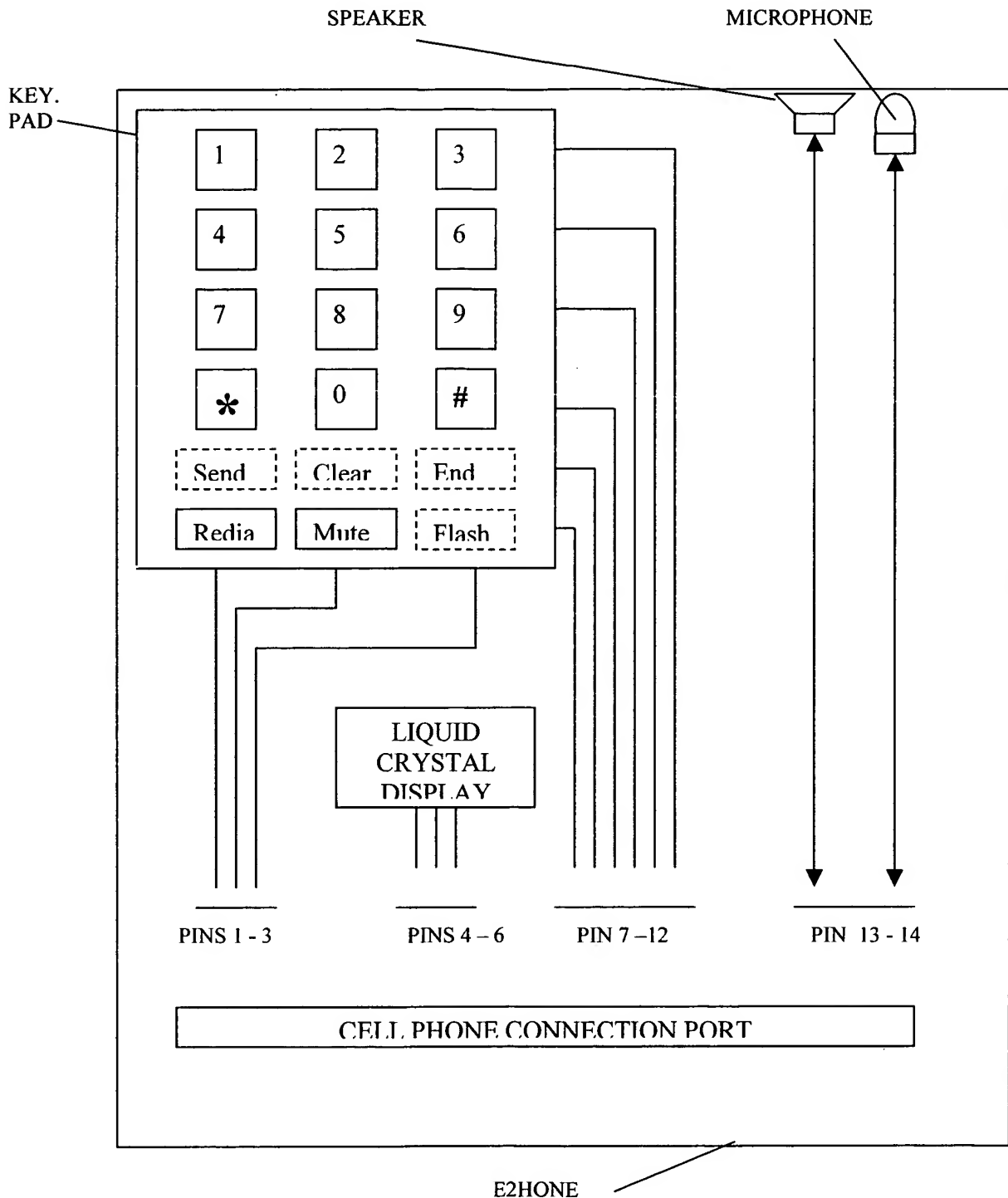


FIGURE 11B